

REMARKS

The present Amendment and Response is intended to be fully responsive to all points of objections and/or rejections raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Prompt and favorable reconsideration and allowance of the pending claims are respectfully requested.

Status of the Claims

Claims 1-13 and 15-20 are currently pending.

Claims 1-4 have been amended without prejudice.

Claims 15-20 have been newly added.

Applicants assert that the amendments and newly added claims are supported by the specification of record and add no new matter. For example, supports for the new claims and amendment may be found throughout Figures 3-12 and related description.

Remarks to Claim Rejections

Claim Rejections - 35 U.S.C. §103

The February 27, 2009 Office Action rejected claims 1 and 5-6 under 35 U.S.C. §103(a), as being unpatentable over Larson (US 5,160,579) in view of Hirose et al. (US 6,591,495, “Hirose”).

Applicants respectfully disagree.

In rejecting claim 6, the Office Action alleges that Larson teaches removing said first resist pattern 16 (FIG. 1I) and forming a second resist pattern 20 and 22 on said areas of said metal foil. Applicants respectfully disagree.

Applicants would like to point out that Larson does not form the alleged second resist pattern 20 and 22 on said areas of said metal foil, which is specifically required by claim 6 of the present application. By reading claims 5 and 6, a person skilled in the art will appreciate that “said areas of said metal foil” in claim 6 clearly refers to the areas of metal foil not covered by the plating layer. In other words, “said areas of said metal foil” clearly refers to the areas where the removed first resist pattern 16 resides previously. Based upon the allegation made by the Office Action, this would correspond to the areas underneath the (now) removed resist pattern 16 and between resist patterns 20 and 22, as being indicated in the below reproduced FIG. 1I of Larson by the dark arrow. Therefore, the alleged second resist pattern 20 and 22 is different from what is claimed as the second resist pattern by claim 6 of the present application.

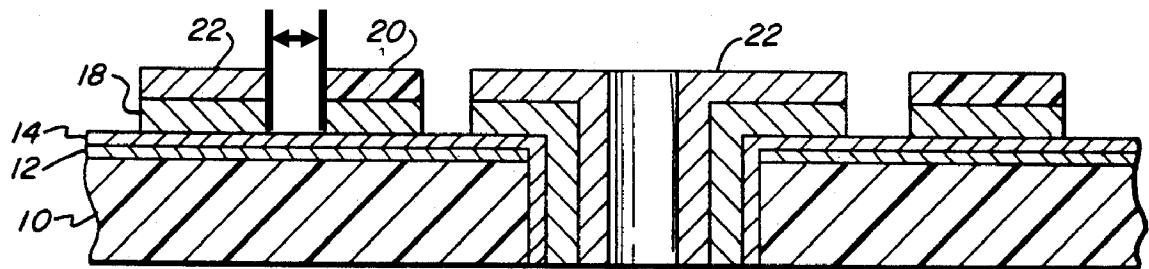


FIG. 1I

Furthermore, after careful analysis of FIGS. 1I-1L and related description in the description of Larson, Applicants were not able to identify any factual evidence which may even possibly suggest that Larson teaches applying a second resist pattern in the areas underneath resist pattern 16 after resist pattern 16 is removed.

The Office Action continues to allege that Larson teaches selectively forming ... using said second resist pattern; ...; and removing said second resist pattern. However, without even the existence of the alleged second resist pattern, as being discussed above, it is clear that these allegations do not stand by themselves.

In rejecting claims 1 and 5, after clearly admitting the deficiencies of Larson, the Office Action contends that Hirose teaches “forming areas of said up surface of said

metal foil not covered by said plating layer into one or more lines, said one or more lines being separated from said area of said up surface covered by said plating layer and including a portion of said up surface” by merely citing element 88 (of Hirose) without any explanation.

In the absence of any specifics and/or detailed explanation provided by the Office Action, Applicants respectfully disagree with the above allegation.

Applicants would like to point out that the Office Action has failed to point out any plating layer, if Hirose ever teaches, such that the areas being formed into one or more lines 88 are areas not being covered by such plating layer, and the formed one or more lines 88 are separated from areas that are covered by such plating layer. In fact, Applicants have carefully analyzed prior art Hirose, and have found no such plating layer to possibly support the above allegation made by the Office Action in rejecting claims 1 and 5 of the present application. In view of this, Hirose does not cure the deficiency of Larson in teaching each and every element of claims 1 and 5 of the present invention.

Moreover, Applicants respectfully submit that all the prior art references of record, in particular Larson and Hirose, alone or in combination, do not teach, suggest, or even imply each and every elements of independent claims 1 and 5 of the present application. In view of that and in accordance with MPEP 2142 (in order to establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest all the claim limitations), it is respectfully submitted that independent claims 1 and 5 are neither anticipated by, nor obvious over, all the prior art references of record and are patentable.

The February 27, 2009 Office Action additionally rejected claims 3 and 7 as being unpatentable over Larson and Hirose, and further in view of Shipley (US 4,902,610); rejected claims 2 and 8-9 as being unpatentable over Larson and Hirose, and further in view of Tamm et al. (US 5,666,722, “Tamm”); rejected claim 4 as being unpatentable over Larson and Hirose and Tamm, and further in view of Shipley; rejected claim 10 as

being unpatentable over Larson and Hirose and Shipley, and further in view of Tamm; rejected claims 11-12 as being unpatentable over Larson and Hirose and Tamm, and further in view of Asai et al. (US 6,828,510, "Asai"); and rejected claim 13 as being unpatentable over Larson and Hirose and Shipley and Tamm, and further in view of Asai, all under 35 U.S.C. §103(a).

Applicants respectfully disagree.

Claims 2-4 depend from claim 1 and include all the distinct elements of claim 1 as well as other distinctive features and/or elements. Claims 7-13 depend from claim 5 and include all the distinct elements of claim 5 as well as other distinctive features and/or elements. Therefore, claims 2-4 and 7-13 are patentable for at least the same reasons as discussed above with regard to claim 1 or claim 5.

In view of the above, it is respectfully requested that rejections of claims 1-13 made under 35 U.S.C. §103(a) be withdrawn.

Notwithstanding above deficiencies of the Office Action in rejecting claims 1-13 of the present application, in a good faith to advance prosecution of present application, Applicants have voluntarily amended claims 1-4 to more clearly define and recite the distinctive features and elements of the present invention. Amendments of claims 1-4 are made without conceding any appropriateness of rejections of claims 1-4 made in the February 27, 2009 Office Action, as claims 1-4 are clearly patentable in their currently existing forms before the present amendment, as being discussed above in detail.

Applicants have added new claims 15-20, in this paper, that include distinctive features and/or elements that are not taught, suggested, or even implied by prior art references of record, alone or in combination. In view of this, Applicants respectfully submit that new claims 15-20 are patentable.

Conclusion

In view of the preceding remarks, Applicants respectfully submit that all pending claims are now in condition for allowance. Favorable reconsideration and allowance of the claims are respectfully requested.

No fees are believed to be due in connection with this paper. However, if there is any such fee due, please charge any such fee to deposit account No. 09-0458.

Respectfully submitted,

/Yuanmin Cai/

Yuanmin Cai, Ph.D.
Agent for Applicant(s)
Registration No. 56,513

Dated: May 14, 2009

INTERNATIONAL BUSINESS MACHINE CORPORATION

Intellectual Property Law Department, East Fishkill
2070 Route 52, Bldg-321, Zip-482
Hopewell Junction, NY 12533
Tel: (845) 894-8469
Fax: (845) 892-6363